

### REMARKS

Applicant has reviewed and considered the Office Action mailed on August 14, 2003, and the references cited therewith.

No claims are amended, canceled, or added herein; as a result, claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35, 36, 39 and 44-51 remain pending in this application.

#### §103 Rejection of the Claims

Claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35, 36, 39 and 45-51 were rejected under 35 USC § 103(a) as being unpatentable over Matthews (U.S. 6,025,837) in view of Schein (U.S. 6,247,176), Ohga (U.S. 5,465,385), and Marsh (U.S. 6,208,799). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection because the cited references do not teach each and every element of Applicant's claims.

For example, claim 1 recites "a user initiated scheduling process operable to provide an interface for a user to determine a scheduled time and channel for electronic program guide data in an in-band data broadcast, and for invoking the real-time scheduling process to schedule execution of a caching process at approximately the scheduled time." The Office Action admits that Matthews does not disclose that the user interface further enables the user to determine a scheduled time and channel of the EPG data. However, the Office Action attempts to make up for the deficiency in Matthews by asserting that Schein, at column 6, lines 21-40, discloses the recited language. Applicant respectfully disagrees with this interpretation of Schein. As is clear from the cited section, Schein merely teaches that a user may select one of several instances of a show may be scheduled (emphasis added). The system in Schein will then cause a VCR to

record the show at the scheduled time. This is different from Applicant's claimed invention, in which EPG data, not a show, is cached at a scheduled time. Further, Applicant can find no teaching or disclosure of the recited language in Ohga or Marsh. As a result, the combination of Matthews, Schein, Ohga and Marsh fails to teach each and every limitation of Applicant's claim 1. Applicant respectfully traverses the rejection and requests reconsideration and withdrawal of the rejection of claim 1.

Claims 2 – 6 depend from claim 1 and therefore inherit the elements of claim 1 while adding further patentable distinctions. Claims 2-6 are therefore allowable for the same reasons as discussed above with respect to claim 1.

In addition, claim 2 recites retrieving the scheduled time and channel from a source while claim 3 recites that the source is an in-band data broadcast. In other words, the schedule of EPG transmissions is itself obtained from a source. The Office Action asserts that the recited language reads on the combination of Matthews and Schein. Applicant respectfully disagrees with this interpretation of the cited references. The Office Action fails to identify any structure in Matthews or Schein that serves as a schedule of EPG data transmissions (i.e. a schedule for a transmission of a schedule of programs). Applicant can find no teaching or disclosure in Matthews, Schein, Ohga or Marsh of the recited language. As a result, the cited references fail to teach each and every element of Applicant's claims 2 and 3. Applicant respectfully requests the withdrawal of the rejection of claims 2 and 3.

Claim 9 was rejected for the same reasons as claim 1. Applicant submits that the arguments above with respect to claim 1 fully apply to claim 9. The Office Action further states that the "user is enabled to choose to receive EPG data broadcasts." Applicant notes that Matthews does not teach or disclose that the user can choose a scheduled time for receiving the EPG broadcast, rather the EPG data appears to be received in response to the user's request. Receiving a response to a request is different from scheduling a time for receiving EPG data. As a result, neither Matthews nor the other cited references teach each and every element of claim 9. For the above reasons, Applicant respectfully requests the withdrawal of the rejection of claim 9.

Claims 10 – 13 depend from claim 9 and therefore inherit the elements of claim 9 while adding further patentable distinctions. Claims 10-13 are therefore allowable for the same reasons as discussed above with respect to claim 9.

Furthermore, claim 10 recites “displaying a plurality of schedules to a user for selection”, while claim 18 recites “the scheduled time and the channel are selected by a user of the digital processing system from a plurality of data service schedules.” The Office Action asserts that FIG. 3 of Schein teaches the recited language. Applicant respectfully disagrees. Rather than a plurality of schedules, FIG. 3 of Schein appears to be a display of a single schedule of multiple broadcasts of a show “Gone with the Wind.” This is different from a plurality of schedules. Thus neither Schein nor the other cited references teach or disclose each and every element of Applicant’s claims 10 and 18. Applicant respectfully requests the withdrawal of the rejection of claims 10 and 18.

Claims 11, 12, 19 and 22 recite similar language to that of claims 2 and 3. Applicant submits that claims 11, 12 19 and 22 are allowable for the same reasons as discussed above with respect to claims 2 and 3.

Claim 15 was rejected for the same reasons as claim 9, which was rejected using the same rationale as claim 1. Applicant respectfully submits that the claim 15 is allowable for the same reasons as discussed above with respect to claims 1 and 9. Applicant respectfully requests the withdrawal of the rejection of claim 15.

Claims 16, 21 and 25 were rejected for the same reasons as claim 1. Applicant respectfully submits that the arguments above with respect to claim 1 apply as well to claims 16, 21 and 25 and respectfully requests the withdrawal of the rejection of claims 16, 21 and 25. Further, claim 25 specifically recites that the scheduled information is “non-audio and non-video information”. Applicant notes that Schein teaches the scheduling of shows, which are at least video and most likely include audio information. As a result, Schein does not teach the scheduled receipt of non-audio and non-video information.

Claims 17-19 depend from claim 16, claims 22-23 depend from claim 21, and claims 28-31 depend from claim 25. These dependent claims therefore inherit the elements of their respective base claims in addition to providing further patentable distinctions. Applicant submits that claims 17-19, 22-23 and 28-31 are therefore allowable for at least the same reasons as their respective base claims 16, 21 and 25 respectively, which in turn are allowable for the same reasons as discussed above with respect to claim 1. Applicant respectfully requests the withdrawal of the rejection of claims 17-19, 22-23 and 28-31.

In addition, claim 29 was rejected because the features of the claim are asserted to be met by the combination of Matthews and Schein. However, no supporting details were provided in the rejection. Applicant respectfully submits that claim 29 is allowable for at least the same reasons as discussed above with respect to claim 1.

Claim 32 was rejected for the same reasons as claim 9. Applicant respectfully submits that claim 32 is allowable for the same reasons as discussed above with respect to claim 9 (and also claim 1). Applicant requests reconsideration and the withdrawal of the rejection of claim 32.

Claim 35 depends from claim 32 and is therefore non-obvious for at least the same reasons as claim 32.

Claim 36 was rejected using the same rational as claim 1. Applicant submits that claim 36 is non-obvious for the same reasons as discussed above with respect to claim 1. Applicant requests reconsideration and withdrawal of the rejection of claim 36.

Claim 39 depends from claim 36, and is therefore non-obvious for at least the same reasons as claim 36 (and therefore claim 1).

Claim 45 recites that the real time scheduling process schedules "multiple executions of the caching process." The Office Action states that the recited language is broad enough to read on Matthews and Schein, since "the user is enabled to choose and execute multiple broadcast programs." Applicant respectfully disagrees with this interpretation of the cited references. The cited references may allow a user to select recording of multiple programs, however this does not imply execution of multiple caching processes. The Office Action has not identified any structure corresponding to multiple caching processes. Therefore the cited references do not teach each and every element of Applicant's claim 45. Applicant respectfully requests the withdrawal of the rejection of claim 45.

With respect to claims 46-51, the Office Action asserts that because Schein teaches requesting information from the Internet, that it would be obvious to one of ordinary skill in the art at the time the invention was made to provide a subscriber any additional types of data. Applicant respectfully disagrees and traverses the rejection. Schein merely teaches that content such as a show can be obtained over the Internet. Schein does not teach the scheduled reception of information such as stock quotes and sports scores.

Additionally, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action states that the motivation to combine Matthews and Schein is “providing the subscriber with a wider range of information.” Applicant respectfully submits that the cited motivation to combine is not found in the references themselves. The cited references do not state that their purpose or benefit is to provide a wider range of information. As a result, the statement in the Office Action is merely a conclusory statement of belief and not specific objective evidence of a motivation to combine.

For the above reasons, Applicant respectfully requests the withdrawal of the rejection of claims 46-51.

Claim 44 was rejected under 35 USC § 103(a) as being unpatentable over Matthews, Schein, Ohga and Marsh as applied to claim 1, and further in view of Klosterman (U.S. 5,550,576). Claim 44 depends from claim 1 and therefore inherits the element of “a user initiated scheduling process operable to provide an interface for a user to determine a scheduled time and channel for electronic program guide data in an in-band data broadcast, and for invoking the real-time scheduling process to schedule execution of a caching process at approximately the scheduled time.” As discussed above with respect to claim 1, none of Matthews, Schein, Ohga or Marsh teach or disclose the recited language. Applicant has reviewed Klosterman and can find no teaching or disclosure of the cited language. Applicant respectfully requests withdrawal of the rejection of claim 44.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, **Rodney L. Lacy (612-373-6954)** to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of February, 2004 (Tuesday following a federal holiday).

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